



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/840,081

05/06/2004

Eric Swann

65678-0060

7852

10291 7590 07/09/2008
RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

EXAMINER

CHONG CRUZ, NADJA N

ART UNIT

PAPER NUMBER

3623

NOTIFICATION DATE

DELIVERY MODE

07/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary	Application No. 10/840,081	Applicant(s) SWANN ET AL.	
	Examiner NADJA CHONG CRUZ	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>29 Oct 2004 & 25 May 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This is a Non-Final office action in reply to the application filed on 6 May 2004.
2. Claims 1-35 are currently pending and have been examined.

Priority

3. Applicant's claim for the benefit of a prior-filed application, Provisional Application No. 60/166,042, under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **Figures 4A-4C and its reference signs**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Art Unit: 3623

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **Figure 4: 198 and 200; Figure 5: 210-230; Figure 6: 230-246; Figure 7: 250-278; Figure 11: 400-440; Figure 12: 450-480; Figure 13: 500-532; Figure 14: 600-638, Figure 15: 650-692, Figure 18: 1000-1049; Figure 19: 1050-1097; Figure 20: 1100-1136 and Figure 21: 1150-1184.** Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
6. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Examiner suggests: Asset Management System and Method for Analyzing Information Organized in a Configurable Manner.

8. The disclosure is objected to because of the following informalities:
9. The use of the trademarks PALM, MICROSOFT and WINDOW on page 27 ¶ 0104 and WINDOWS 98, WINDOWS MILLENIUM and WINDOWS 2000 on page 30 ¶ 00113 have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.
10. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
11. It appears to be that the word "Figure 10" is missing on page 36 ¶ 00129.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
13. Claims 1-15 and 26-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claims 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitations *first configurable template is also said second configurable template* and *third configurable template is also said first configurable template and said second configurable template* does not further limit or clarify how many configurable templates are or is only one configurable template. For the purposes of this examination, the examiner will assume a plurality of configurable templates.
15. As per Claim 1 recites the limitations *the storage*, *said attribute records* and *the attribute record*. There is insufficient antecedent basis for these limitations in the claims
16. As per claim 26 recites the limitation *the data*. There is insufficient antecedent basis for these limitations in the claims

Claim Rejections - 35 USC § 101

17. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

18. Claims 16-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 16 recites a data structure which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.
19. Claims 26 – 35 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).
20. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

21. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 26-35 are non-statutory since they may be preformed within the human mind. Claims 27-35 inherit the same deficiencies as claim 26 and are therefore rejected for the same reasons as claim 26.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

23. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: please provide additional details regarding Wyzdom ® Asset Management Software or other products/services for asset management and monitoring (e.g. please provide the user's guides for all versions of the Wyzdom ® Asset Management Software and products/services available prior to the submission of the instant application, including at least user's guide, manuals or other documentations detailing the capabilities, features and functions of previous versions of the Wyzdom ® Asset Management Software) including details as to when various releases/versions of the product were available and/or sold.
24. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.
25. Claims 1-2, 5-7, 10-13, 15-16, 18-21, 23-30, 33 and 35 are rejected under 35 U.S.C. 102(b) as being unpatentable over Dana's Wyzdom Product (System and Method) as evidenced by at least the following references:

Art Unit: 3623

- Dana Commercial Credit's Technology Management Group Introduces Web-Based Version of Wyzdom ® Software, PR Newswire, Jan. 19, 1998, hereinafter "reference A1".
- DCC Technology Management Group Announces Free Asset Management Software Upgrade; Special Offer for new Customers, PR Newswire, Aug. 10, 1998, hereinafter "reference A2".
- Dana Commercial Credit's Technology Management Group Announces Release of Wyzdom 5.2 Asset Management Software, PR Newswire, Oct. 26, 1998, hereinafter "reference A3"
- Dana Corporation / Dana Commercial Credit <http://web.archive.org/web/19980505224929/http://dcc.com/>, Nov. 11, 1997-Feb. 17-1999, hereinafter "reference A4".
- Clinton Wilder, Enterprise Java apps hit the market; Information Week; Jan 19, 1998, hereinafter "reference A5".

Claim 1:

Dana's Wyzdom Product as shown discloses a system enabling a user to manage and analyze assets information, the system comprising:

- *a data device* (Reference A1, page 2, 6th ¶: "Wyzdom is platform- and database-independent" which teaches that Wyzdom is a data device to manage information);
- *said data device including a plurality of attribute types in an embodiment of a data design* (Reference A1, page 1, last ¶: which teaches that "Wyzdom enables corporation to manage desktop assets by integrating information on the physical, financial and contractual aspects" (e.g., a plurality of attribute types) "of each IT asset". Reference A1 teaches that a web-based solution version of Wyzdom software enable the user to manage a plurality of attributes types in the data design);
- *wherein said data device provides for the storage of said attribute records in accordance with said data design* (Reference A1, page 1, last ¶: "Wyzdom

maintains and updates the history of each piece of equipment to control usage cost during its entire life cycle” which teaches that data is stored and it is maintained and updated);

- *an application device* (Reference A1, page 1, title: “Web-Based Version of Wyzdom(R) Software”);
- *said application device including an application incorporating said data design, said application including a configurable template, wherein a modification to said configurable template automatically modifies said data design* (Reference A3, page 2, 3rd ¶: “XML Technology -- provides a way to facilitate the creation of customizable documents” (e.g., configurable template) “within a web browser. XML, or Extensible Markup Language, allows forms to be “active” by extracting data from the database into a formatted template. This enables clients to customize documents” (e.g., to perform a modification) “such as purchase orders, invoices and receipts with corporate information and logos, thereby adhering to corporate or departmental standards” which teaches that when a user modify a purchase order template it automatically modify the relationship between the purchase department with the other organization department in order to comply with these new requirements);
- *and wherein said application provides for generating an analysis from the attribute records in said data device* (Reference A1, page 3, 1st ¶: “[a]uthorized users have the ability to analyze, report and act on IT asset performance, return on investment and total cost of ownership” which Reference A1 suggests that Wyzdom allows the user to generate analysis and reports from the attribute records (e.g., asset performance));

Claim 2:

Dana’s Wyzdom Product as shown discloses the following limitation:

- *wherein said plurality of attribute types includes a transaction attribute type, an asset attribute type and an organization attribute type, (Reference A1, page 1, last ¶: “to manage desktop assets by integrating information on the physical” (e.g., asset attribute type, “financial” (e.g., transaction attribute type) “and contractual aspects” (e.g., organization attribute type) “of each IT asset.”);*
- *and wherein each attribute type corresponds to a plurality of attribute records (Reference A1, page 1, last ¶: Wyzdom maintains and updates the history of each piece of equipment to control usage cost during its entire life cycle” which teaches that the history (e.g., attribute records) of each attribute type is maintained and updated);*

Claim 5:

Dana’s Wyzdom Product as shown discloses the following limitation:

- *wherein said application can modify the number of configurable templates (Reference A3, page 2, 3rd ¶: “XML Technology -- provides a way to facilitate the creation of customizable documents” (e.g., configurable templates) “within a web browser” because it “allows forms to be “active” by extracting data from the database into a formatted template” in order “to customize documents such as purchase orders, invoices and receipts with corporate information and logos, thereby adhering to corporate or departmental standards.”);*

Claim 6:

Dana’s Wyzdom Product as shown discloses the following limitation:

- *further comprising a web server, wherein said application resides on a web server (Reference A1, title: “[w]eb-Based Version of Wyzdom ® Software” which teaches that Wyzdom is available through a web server);*
- *and wherein said application provides for interactions with a plurality of users associated with a plurality of organizations in a simultaneous or substantially*

simultaneous manner (Reference A3, page 2, 6th ¶: “[a]ny of Wyzdom's functions can be accessed through the Internet or through an organization's Intranet” (e.g., plurality of users accessing an application in an organization). “Furthermore, Wyzdom can be accessed as an applet, using any web browser.” Reference A3 suggests that a plurality of users within a plurality of organization interacts with the web-based version of Wyzdom in a simultaneously manner through the web server by using any web browser);

Claim 7:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein access to said application is sold in accordance with an application service provider agreement* (Reference A2, page 2, 3rd ¶ and 7th ¶: “[t]he free software upgrade entails replacing the customer's current asset management repository with Wyzdom, licensed according to the customer's existing software agreement” and “[t]his and future Wyzdom software upgrades are covered under the client software support agreement” which Reference A2 suggests an application service provider agreement which is well known in software/application distribution and implementation);

Claim 10:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said application is an asset management program* (Reference A1, page 1, 1st ¶: which teaches “Wyzdom(R), a proprietary asset management software program designed to track and manage assets throughout the product lifecycle”);
- *and wherein said analysis relates to a cost-benefit analysis of at least one said attribute type* (Reference A1, page 1, 3rd ¶: which teaches that Wyzdom enable the user obtain “streamlining costs of desktop assets, and actually realizing a return on

their IT investments." Reference A1 suggests that in order to obtain a return on their investments, a cost-benefit analysis is performed);

Claim 11:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said attribute records are populated by a manual data entry process* (Reference A3, page 2, 4th ¶: which teaches that "manual data entry", Reference A3 suggests that the attribute records were populated by manual data entry, which is well known in the art to enter data through an input device (e.g., keyboards));

Claim 12:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said attribute records are populated by a batch upload process* (Reference A1, page 1, 3rd ¶: "[w]yzdom enables corporations to manage desktop assets by integrating information" and "maintain and updates the history of each piece of equipment". Reference A1 suggests that a batch upload process is executed in order to integrate, maintain and update information. Furthermore, a batch upload process is well known in the art to provide flexibility to enter data transactions but not initiate the change until a later time and, to verify data changes that are initiated from another entity prior to processing);

Claim 13:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said attribute records are populated by an automated transfer process from a first computer to a second computer* (Reference A3, page 2, 4th ¶: "The Integration Accelerator -- an enhanced version of the Wyzdom Application Programming Interface (API)" where "[t]his tool allows clients and integration partners to bypass the user interface and share large volumes of information between systems" (e.g., a plurality of computers). Reference A3 suggests an

automated transfer process in order to share large volumes of information which is well known in the art to transfer data automatically from one computer to another computer);

Claim 15:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said attribute records are populated automatically by an interfacing computer program* (Reference A5, Figure "First to market" which it illustrates a computer program interface to populate automatically attribute records);

Claim 16:

Dana's Wyzdom Product as shown discloses a system enabling a user to manage and analyze assets information, the system comprising:

- *a database, said database including a data design* (Reference A1, page 2, 6th ¶: "Wyzdom is platform" (e.g., a data design) "- and database-independent" which teaches that Wyzdom store and manage information);
- *and a plurality of attributes, said plurality of attributes comprising a plurality of attribute types, and a plurality of attribute values* (Reference A1, page 1, last ¶: which teaches that "Wyzdom enables corporation to manage desktop assets by integrating information on the physical, financial and contractual aspects" (e.g., a plurality of attribute types and values) "of each IT asset". Reference A1 teaches that a web-based solution version of Wyzdom software enables the user to manage a plurality of attributes types and values);
- *wherein said plurality of attribute values are associated with said plurality of attribute types in accordance with said data design; said plurality of attribute types comprising: a plurality of asset attributes; a plurality of organization attributes; a plurality of transaction attributes* (Reference A1, page 1, last ¶: "to manage desktop assets by integrating information on the physical" (e.g., asset attributes: types and

values), "financial" (e.g., transaction attributes: types and values) "and contractual aspects" (e.g., organization attribute: types and values) "of each IT asset.");

- *an asset management application* (Reference A1, page 1, 1st ¶: which teaches "Wyzdom(R), a proprietary asset management software program designed to track and manage assets throughout the product lifecycle");
- *said application including a plurality of templates* (Reference A3, page 2, 3rd ¶: "XML Technology -- provides a way to facilitate the creation of customizable documents" (e.g., configurable templates) "within a web browser" because it "allows forms to be "active" by extracting data from the database into a formatted template" in order "to customize documents such as purchase orders, invoices and receipts with corporate information and logos, thereby adhering to corporate or departmental standards.");
- *and an asset analysis* (Reference A1, page 3, 1st ¶: "[a]uthorized users have the ability to analyze, report and act on IT asset performance, return on investment and total cost of ownership" which Reference A1 suggests that Wyzdom allows the user to generate analysis and reports from an asset);
- *wherein each template in said templates provides for the modification of a subset of said data design* (Reference A3, page 2, 3rd ¶: "XML Technology -- provides a way to facilitate the creation of customizable documents" (e.g., configurable template) "within a web browser. XML, or Extensible Markup Language, allows forms to be "active" by extracting data from the database into a formatted template. This enables clients to customize documents" (e.g., to perform a modification) "such as purchase orders, invoices and receipts with corporate information and logos, thereby adhering to corporate or departmental standards" which teaches that when a user modify a purchase order template it automatically modify the relationship

between the purchase department with the other organization department in order to comply with these new requirements);

- *said plurality of templates including an asset template, an organization template, and a transaction template* (Reference A3, page 2, 3rd ¶: “[this enables clients to customize documents such as purchase orders, invoices and receipts” (e.g., transaction templates) “with corporate information and logos, thereby adhering to corporate or departmental standards”);
- *and wherein said application provides for generating said asset analysis from at least one said asset attribute, at least one said organization attribute, and at least one said transaction attribute* (Reference A4, page 16, Dana Commercial Credit Company Technology Management Overview, 2nd ¶: which teaches that “WYZDOM?” is “a comprehensive asset management database system that manages the physical” (e.g., asset attribute) “financial” (e.g., transaction attribute) “and contractual” (organizational attribute) “asset details required to make strategic decisions on IT procurement, deployment, maintenance and disposal”. Reference A4 suggests that in order to make a strategic decision an asset analysis have been performed considering all asset details);

Dana’s Wyzdom product does not expressly teach the specific data *asset template* and *organization template* recited in the limitations, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ‘ 2106);

Claim 18:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said plurality of transaction attributes include a plurality of transaction types comprising at least three of: a lease, a rent; purchase; a sale; a depreciation; an interest payment; an asset management fee; a maintenance contract; a project management; a repair; an abuse; a freight charge; (Reference A1, page 2, 1st ¶: "[w]yzdom manages data including equipment lease termination and renewal dates manufacturer warranties, service agreements, maintenance logs, software packages and licenses, component upgrades");*
- *a tax (Reference A1, page 2, 1st ¶: "and tax payment schedules");*
- *and a travel cost (Reference A5, Figure "First to market" which it illustrates an expense report (e.g., travel cost) for Smith, Jane);*

Claim 19:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said plurality of asset attributes includes an accounting characteristic and a physical characteristic (Reference A1, page 1, last ¶: "to manage desktop assets by integrating information on the physical" (e.g., physical characteristic), "financial" (e.g., accounting characteristic) "and contractual aspects of each IT asset");*

Claim 20:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said asset analysis is a profitability analysis (Reference A1, page 2, 1st ¶: "[a]uthorized users have the ability to analyze, report and act on IT asset performance, return on investment and total cost of ownership" which Reference A1 suggests a profitability analysis is made in order to obtain a return on investment);*

Claim 21:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said asset analysis does not relate to a monetary value* (Reference A1, page 2, 1st ¶: "[a]uthorized users have the ability to analyze, report and act on IT asset performance" which Reference A1 suggests an asset analysis based on asset performance);

Claim 23:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said application provides for creating, additional templates* (Reference A3, page 2, 3rd ¶: "XML, or Extensible Markup Language, allows forms to be "active" by extracting data from the database into a formatted template. This enables clients to customize documents" Wyzdom database-independent enables the user to customize documents (e.g., create or modify existing documents) which is well known in the art that a database allow the user to create additional templates);

Claim 24:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said application provides for creating additional attribute types* (Reference A4, page 17, 1st ¶: "Wyzdom is a web-based, 100% Java, asset management solution. Wyzdom provides the ability to access all physical, financial and contractual asset information from one centralized database". Reference 5A suggests that in order to access information, attribute types were previously created and entered in the centralized database, which is well known in the art to create additional attribute types in a database);

Claim 25:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said application provides for modifying said attribute types* (Reference A1, page 1, last ¶: “[w]yzdom maintains and updates the history of each piece of equipment” where an update is a modification to an asset);

Claim 26:

Dana’s Wyzdom Product as shown discloses a method enabling a user to manage and analyze assets information, the method comprising:

- *providing an application supported by an underlying data design* (Reference A1, page 1, title: “Web-Based Version of Wyzdom(R) Software”);
- *capturing a plurality of organization attributes through the use of a first configurable template associated with an application* (Reference A1, page 1, last ¶: “Wyzdom maintains and updates the history of each piece of equipment to control usage cost during its entire life cycle” which teaches that a plurality of attributes are captured in order to maintain and update each asset. Wyzdom is a web-based software which allow the user to input in a plurality of configurable templates, it is commonly known in the art that web-based software is composed of configurable templates (html files, xml files, etc.));
- *receiving a plurality of asset attributes through the use of a second configurable template associated with an application* (Reference A1, page 1, last ¶: “Wyzdom maintains and updates the history of each piece of equipment to control usage cost during its entire life cycle” which teaches that a plurality of attributes are received in order to be maintained and updated. Wyzdom is a web-based software which allow the user to input in a plurality of configurable templates, it is commonly known in the art that web-based software is composed of configurable templates (html files, xml files, etc.));
- *defining a plurality of transaction attributes through the use of a third configurable template associated with an application* (Reference A1, page 1, last ¶: which

teaches that "Wyzdom enables corporation to manage desktop assets by integrating information on the physical, financial and contractual aspects" (e.g., a plurality of attribute types) "of each IT asset". Wyzdom is a web-based software which allow the user to input in a plurality of configurable templates, it is commonly known in the art that web-based software is composed of configurable templates (html files, xml files, etc.));

- *modifying the data design through the use of at least one configurable template* (Reference A3, page 2, 3rd ¶: "XML Technology -- provides a way to facilitate the creation of customizable documents" (e.g., configurable template) "within a web browser. XML, or Extensible Markup Language, allows forms to be "active" by extracting data from the database into a formatted template. This enables clients to customize documents" (e.g., to perform a modification) "such as purchase orders, invoices and receipts with corporate information and logos, thereby adhering to corporate or departmental standards" which teaches that when a user modify a purchase order template it automatically modify the relationship between the purchase department with the other organization department in order to comply with these new requirements);
- *generating an analysis from data stored in accordance with the modified data design* (Reference A1, page 3, 1st ¶: "[a]uthorized users have the ability to analyze, report and act on IT asset performance, return on investment and total cost of ownership" which Reference A1 suggests that Wyzdom allows the user to generate analysis and reports from data stored based on modified data (e.g., asset history updates);

Claim 27:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said first configurable template is also said second configurable template* (Reference A3, page 2, 3rd ¶: "XML Technology -- provides a way to facilitate the creation of customizable documents" (e.g., configurable template) "within a web browser. XML, or Extensible Markup Language, allows forms to be "active" by extracting data from the database into a formatted template." Wyzdom is a web-based software which allow the user to input in a plurality of configurable templates, it is commonly known in the art that web-based software is composed of configurable templates (html files, xml files, etc.));

Claim 28:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein said third configurable template is also said first configurable template and said second configurable template* (Reference A3, page 2, 3rd ¶: "XML Technology -
- provides a way to facilitate the creation of customizable documents" (e.g., configurable template) "within a web browser. XML, or Extensible Markup Language, allows forms to be "active" by extracting data from the database into a formatted template." Wyzdom is a web-based software which allow the user to input in a plurality of configurable templates, it is commonly known in the art that web-based software is composed of configurable templates (html files, xml files, etc.));

Claim 29:

Dana's Wyzdom Product as shown discloses the following limitation:

- *wherein the application is provided by an application service provider* (Reference A1, title: "[w]eb-Based Version of Wyzdom ® Software" which teaches that Wyzdom is available through a web server. It is implicitly disclosed that a web-based version of Wyzdom is provided by an application service provider);
- *for access by multiple organizations in a simultaneous or substantially simultaneous manner* (Reference A3, page 2, 6th ¶: "[a]ny of Wyzdom's functions can be

accessed through the Internet or through an organization's Intranet" (e.g., plurality of users accessing an application in an organization). "Furthermore, Wyzdom can be accessed as an applet, using any web browser." Reference A3 suggests that a plurality of users within a plurality of organization interacts with the web-based version of Wyzdom in a simultaneously manner through the web server by using any web browser);

Claim 30:

Dana's Wyzdom Product as shown discloses the following limitation:

- *further comprising associating a particular transaction type with an accounting procedure* (Reference A1, page 2, 1st ¶: "[w]yzdom manages data including equipment lease termination and renewal dates" in order to analyze a "total cost of ownership" which teaches that lease termination and renewal dates are associated with an accounting procedure with the purpose to track lease/renewal costs);

Claim 33:

Dana's Wyzdom Product as shown discloses the following limitation:

- *further comprising associating a transaction type with an asset type* (Reference A1, page 2, 1st ¶: "[w]yzdom manages data including equipment" (e.g., asset type) "lease termination and renewal dates" (e.g., transaction type) which teaches that Wyzdom associates all attributes related to an asset in order "to analyze, report and act on IT asset performance");

Claim 35:

Dana's Wyzdom Product as shown discloses the following limitation:

- *further comprising adding a configurable template to said application* (Reference A3, page 2, 3rd ¶: "XML Technology -- provides a way to facilitate the creation of customizable documents" (e.g., configurable template) "within a web browser. XML, or Extensible Markup Language, allows forms to be "active" by extracting data from

the database into a formatted template.” Wyzdom is a web-based software which allow the user to input in a plurality of configurable templates, it is commonly known in the art that web-based software is composed of configurable templates (html files, xml files, etc.));

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 3-4, 8-9, 14, 17, 31-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dana's Wyzdom Product (System and Method) as applied to claims 1-2, 5-7, 10-13, 15-16, 18-21, 23-30, 33 and 35 above as evidenced by at least the following references below:

- Dana Commercial Credit's Technology Management Group Introduces Web-Based Version of Wyzdom ® Software, PR Newswire, Jan. 19, 1998, hereinafter “reference A1”.
- DCC Technology Management Group Announces Free Asset Management Software Upgrade; Special Offer for new Customers, PR Newswire, Aug. 10, 1998, hereinafter “reference A2”.
- Dana Commercial Credit's Technology Management Group Announces Release of Wyzdom 5.2 Asset Management Software, PR Newswire, Oct. 26, 1998, hereinafter “reference A3”
- Dana Corporation / Dana Commercial Credit <http://web.archive.org/web/19980505224929/http://dcc.com/>, Nov. 11, 1997-Feb. 17-1999, hereinafter “reference A4”.
- Clinton Wilder, Enterprise Java apps hit the market; Information Week; Jan 19, 1998, hereinafter “reference A5”.

in view of Fearn et al, **Designing Tivoli Solutions for End-to-End Systems and Service Management**, IBM International Technical Support Organization, June 1999, hereinafter "Fearn".

Claim 3:

Dana's Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the purpose of maintaining accurate and current asset information (page 79) as shown, does:

- *further comprising a plurality of assets and a plurality of local controllers, wherein said plurality of local controllers provide for the capturing of information from said plurality of assets, and wherein said information is stored as said attribute records in said data device in accordance with said data design (Chapter 6, Asset Management, page 79, Figure 44, which it illustrates "Update Asset Repository Input Sources" comprising a plurality of assets from different input sources and a local controller "Update Asset Repository" where data is captured and is maintained);*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dana's Wyzdom Product (System and Method) with the plurality of assets and plurality of controllers of the asset management as taught by Fearn because it maintains "an accurate asset information" in the database and it discovers "new information as requested". (Fearn, page 79-80).

Claim 4:

Dana's Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the purpose of identifying and tracking assets (page 129) as shown, does:

- *further comprising a plurality of data hierarchies, said plurality of data hierarchies including an organization hierarchy, an asset hierarchy, and a transaction hierarchy (Chapter 9, Detailed Design and Development, page 129: "[b]y building data*

management hierarchies" (e.g., plurality of data hierarchies) "you can reflect the way the business is structured and provides methods for identifying and tracking assets");

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a set of data hierarchies as taught by Fearn, to improve Dana's Wyzdom asset management product, thereby giving the predictable result of knowing "[w]hat assets are within a certain category", "[w]hat is the location of my assets", "[w]hat assets are assigned to a particular organization", "[w]hat assets are connected to a specific network, for instance, a switch of HUB" and "[w]hat is the value of the assets owned by a particular organization" (Fearn, page 129).

The combination of Dana's Wyzdom product / Fearn does not expressly teach the specific data *organization hierarchy*, *asset hierarchy* and *transaction hierarchy* recited in the limitations, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ' 2106);

Claim 8:

Dana's Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the purpose of accessing information in an asset management (page 128) as shown, does:

- *further comprising a plurality of data designs, wherein each organization assessing said application does so in accordance with said data design associated with said organization* (Chapter 9, Detailed Design and Development, page 128, Figure 62,

which it illustrates “[t]he flows of data into and out of the Asset Repository” between users in an organization);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dana’s Wyzdom Product (System and Method) with the access to the asset management system as taught by Fearn because it enable a users to “access the repository to update data and to generate reports” (Fearn, page 128).

Claim 9:

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the benefit of configurable business rules as shown, does:

- *further comprising a plurality of configurable business rules, wherein said application provides for generating said analysis in accordance with at least one said business rule* (Chapter 3, The Methodologies, page 24: “[e]vent rules for each enterprise significant event” which teaches that a plurality of configurable business rules is assigned to each enterprise significant event (e.g., generating analysis));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a set of configurable business rules as taught by Fearn, to improve Dana’s Wyzdom asset management product, thereby giving the predictable result of providing an ability to “correlate event from different sources based on rules”, “to provide flexible and dynamic correlation rules” and “to initiate actions based on rules (local and on managed entity)” (Fearn, page 109).

Claim 14:

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the purpose of wireless data collection (e.g., automatically) (Figure 62, page 128) as shown, does:

- *wherein said attribute records are populated through a wireless data collection process* ((Chapter 9, Detailed Design and Development, page 128, Figure 62, which it illustrates “[t]he flows of data into and out of the Asset Repository” between users in an organization and 3rd ¶ which teaches that when “[a]n Inventory administrator selects an Inventory profile” in order to initiate “a scan by distributing a profile to the selected workstations.” (e.g., automatically on demand request, wireless data collection) therefore, “[t]he scanner on the endpoints collects the information from the useradd.mif file along with all hardware and software component information. This is sent to the repeater and then on to the Inventory database” (e.g., imported automatically into the database));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a wireless data collection as taught by Fearn, to improve Dana’s Wyzdom asset management product, thereby giving the predictable result of providing “[i]nformation in the Inventory database” in order to be “accessed by problem management staff through queries in the QueryLibrary” to enable a user to “access the repository to update data an to generate reports” (Fearn, page 128).

Claim 17:

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the purpose of providing accurate information regarding the managed assets of the organization including the physical tracking and monitoring of any changes throughout its life cycle (page 74) as shown, does:

- *wherein said plurality of organization attributes include an organization hierarchy* (Chapter 9, Detailed Design and Development, page 129: “[b]y building data management hierarchies” (e.g., an organization hierarchy) “you can reflect the way the business is structured and provides methods for identifying and tracking assets”);

- *a plurality of roles* (Chapter 9, Detailed Design and Development, page 128, Figure 62, which it illustrates a plurality of roles: “Authorized Inventory Administrator”, “Problem Management Staff” and “Authorized Asset Administrator”);
- *and a plurality of business rules* (Chapter 3, The Methodologies, page 24: “[e]vent rules for each enterprise significant event” which teaches that a plurality of configurable business rules is assigned to each enterprise significant event (e.g., generating analysis));
- *wherein said organization hierarchy comprises a plurality of organization levels, including a first organization level and a second organization level* (Chapter 9, Detailed Design and Development, page 129 and Chapter 2, End-to-End Solution – An Overview, page 12: “[b]y building data management hierarchies” (e.g., plurality of data hierarchies) “you can reflect the way the business is structured” (e.g. a plurality of organizational levels) “and provides methods for identifying and tracking assets”. Fearn suggests that a plurality of levels reflect the way a business is structured, such as “the end-user level” (e.g., first/second organization level));
- *and wherein each organization level is associated with a subset of said roles and a subset of said business rules* (Chapter 9, Detailed Design and Development, page 128, last ¶: which teaches the inventory database flows, where an “Inventory Administrator” (e.g., role) “selects an Inventory profile and initiates a scan by distributing a profile to the selected workstations” (e.g., a business rule) where a subset of roles and business rules is associated at each organization level (e.g., authorized inventory administrator);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dana’s Wyzdom Product (System and Method) with the asset management as taught by Fearn because it maintains “an accurate asset information database”, it “integrate seamlessly with other systems management processes, such as: • Problem management, •

Change management, • Service Level management”, it provides “consolidated asset information for reporting and measurement of the process” and it “satisfy all requests for asset information that fall within the business strategy.” (Fearn, page 74-75).

Claim 31:

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the benefit of configurable business rules with a particular role as shown, does:

- *further comprising associating a particular business rule with a particular role in an organization* (Chapter 9, Detailed Design and Development, page 128, last ¶: which teaches the inventory database flows, where an “Inventory Administrator” (e.g., a particular role) “selects an Inventory profile and initiates a scan by distributing a profile to the selected workstations” (e.g., a business rule) where a particular role and a particular business rule (e.g., a scan by distributing a profile to the selected workstations) are associated to an authorized inventory administrator);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a set of configurable business rules as taught by Fearn, to improve Dana’s Wyzdom asset management product, thereby giving the predictable result of providing an ability to “correlate event from different sources based on rules”, “to provide flexible and dynamic correlation rules” and “to initiate actions based on rules (local and on managed entity)” (Fearn, page 109).

Claim 32:

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the purpose of acquiring assets of sub-unit of an organization as shown, does:

- *further comprising associating the ability to possess assets to a particular sub-unit of an organization* (Chapter 9, Detailed Design and Development, page 128, 3rd ¶ and Figure 62, which it illustrates how asset collection (e.g., collection files) is performed to a particular sub-unit of an organization (e.g., a user), where “[t]he scanner on the endpoints collects the information from the useradd.mif file along with all hardware and software component information” (e.g., asset information));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dana’s Wyzdom Product (System and Method) with the ability to possess assets as taught by Fearn because it maintains “an accurate asset information database”, it “integrate seamlessly with other systems management processes, such as: • Problem management, • Change management, • Service Level management”, it provides “consolidated asset information for reporting and measurement of the process” and it “satisfy all requests for asset information that fall within the business strategy.” (Fearn, page 74-75).

Claim 34:

Dana’s Wyzdom Product (System and Method) disclose the following limitation:

- *and a transaction attribute* (Reference A1, page 2, 1st ¶: “[w]yzdom manages data including equipment lease termination and renewal dates manufacturer warranties, service agreements, maintenance logs, software packages and licenses, component upgrades”);

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Fearn in an analogous art of asset management for the benefit of configurable business rules associated to an attribute as shown, does:

- *further comprising association an asset attribute, an organization attribute, with a business rule* (Chapter 9, Detailed Design and Development, page 128, last ¶: which teaches the inventory database flows, where an “Inventory Administrator” (e.g., an organization attribute) “selects an Inventory profile” (e.g., an asset

attribute) and initiates a scan by distributing a profile to the selected workstations” (e.g., a business rule) where an asset attribute and organization attribute are associated with a business rule (e.g., a scan by distributing a profile to the selected workstations));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use associate attributes with a set of configurable business rules as taught by Fearn, to improve the Dana’s Wyzdom asset management product, thereby giving the predictable result of providing an ability to “correlate event from different sources based on rules”, “to provide flexible and dynamic correlation rules” and “to initiate actions based on rules (local and on managed entity)” (Fearn, page 109).

28. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dana’s Wyzdom Product (System and Method) in view of Codd et al, **Providing OLAP (On-line Analytical Processing)**, *Codd & Date, Inc*, 1993, <http://www.fpm.com/refer/codd.html>, hereinafter “Codd”.

Claim 22:

Dana’s Wyzdom Product (System and Method) does not disclose the following limitation, however Codd in an analogous art of On-line Analytical Process for the purpose to allow the user to view analysis on-line as shown, does:

- *wherein said asset analysis is created with an on-line analytical processing-based functionality* (page 1, Abstract and page 3, 11. Flexible reporting: “[r]eporting facilities should present information in any way the user wants to view it.” Codd teaches that On-line Analytical Processing (OLAP) is well known in the art “to consolidate, view and analyse data according to multiple dimensions.”);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use on-line analytical processing (OLAP) as taught by Codd, to improve Dana’s Wyzdom asset management product, thereby giving the predictable result of accessing

“heterogeneous sources of data and perform any conversions necessary to present a coherent view to the user.” (Codd, page 2, Accessibility).

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- **Dana Commercial Credit Introduces “Total Cost of Ownership” Tool for Information Technology Equipment**, 1998, which disclose that Total Cost of Ownership (TCO) is a tool that help companies to identify savings associated with cost-effective IT asset management
 - Wayne Schulz. **Software making it easier to track fixed assets**; *Accounting Today*. New York: Oct 12-Oct 25, 1998. Schulz disclose how to choose the right fixed asset software for accurate tracking and reporting.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nadja Chong** whose telephone number is **571.270.3939**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BETH VAN DOREN** can be reached at **571.272.6737**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nadja Chong/ Examiner, Art Unit 3623

2 July 2008

/Scott L Jarrett/

Primary Examiner, Art Unit 3623